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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,341	11/20/2001	Scott Montgomery	703602.2	2692

34313 7590 05/21/2009
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IP PROSECUTION DEPARTMENT
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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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05/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,341	Applicant(s) MONTGOMERY ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-87, 89-91, 93, 95-105, 124-132 and 138-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 85-87, 89-91, 93, 95-105, 124-132 and 138-147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' amendments received 12 February 2009.
2. This action has been assigned paper number 20090513 for reference purposes only.
3. Claims 85-87, 89-91, 93, 95-105, 124-132, and 138-147 are pending and have been examined.

Information Disclosure Statement

4. The Examiner has considered the Information Disclosure Statement filed 6 February 2009. However, it is noted that cite number 6 belongs in the Foreign Patent Documents section, as it is a Japanese Patent document. Also, as only the summary is in English, the Examiner can only properly consider that part of the submission.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:
 - a. “indexing tracking ID” in at least claim 85;
 - b. “indexing tracking ID request” in at least claim 85;
 - c. “tracking identification string allocation module” in at least claim 124;
 - d. “tracking number request module” in at least claim 142;
 - e. “USPS delivery confirmation code” in at least claim 147.

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6. These objections are not to be confused with rejections under 35 U.S.C. 112 1st paragraph for new matter. The authority for these objections comes from the rule 37 C.F.R. §1.75(d)(1) as noted in MPEP § 608.01(o): “Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner’s amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 C.F.R. §1.75(d)(1).” Applicant should (1) amend their specification to include the above phrases OR (2) amend the claims so the phrases correspond to the ones used in the specification. Either way, Applicant is reminded that no new matter may be added.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 85-87, 89-91, 93, 95-105, 124-132, and 138-147 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

9. Claims 85 and 124 recite "a digital signature derived from the indexing tracking ID." The most relevant sections of Applicants' disclosure appear to be Table 2 and a section of paragraph [0098], which are provided below:

TABLE 2

Item Number	Field Name	Size (Bytes)
<hr/>		
1	Indicia Version Number	1
2	Algorithm ID	1
3	Certificate Serial Number	4
4	Device ID	8
5	Ascending Register	8
6	Postage	3
7	Date	4
8	License ZIP	4
9	Tracking Number	5
10	Software ID	6
11	Descending Register	4
12	Rate Category	4
13	Piece Count	4
14	Signature	40

[0098] ...The "Signature" is the digital signature of items 1-13. It should be noted, however, that the digital signature can be derived from any combination of the items, provided that the unique tracking number is included in the digital signing process.

None of the elements 1-13 in the above table are an "indexing tracking ID" as is claimed. As noted above, the phrase "indexing tracking ID" does not appear in Applicants' specification.

The phrase "indexing tracking ID" does appear in the original claims. However, it is not related to a digital signature.

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10. Claim 147 recites “a digital signature derived from a USPS delivery confirmation code.” Again, the Examiner refers to Table 2 and paragraph [0098]. “USPS delivery confirmation code” does not appear in the table or paragraph. As also noted above, the phrase “USPS delivery confirmation code” does not appear in Applicants’ specification. Claim 144 contains a similar limitation and is rejected under the same basis

Claim Rejections - 35 USC § 112 2nd Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 93 and 124-146 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 93 is indefinite because the naming used fails to clearly set out the subject matter for which Applicants seek patent protection. Claim 93 recites the limitation "the indexing tracking ID" in line 7. Claim 85, from which claim 93 depends, recites “an indexing tracking ID” in line 6. This indexing tracking ID is in response to “a first indexing tracking ID request” as named in claim 93. There is also a "second indexing tracking ID request” in line 4 of claim 93. The recited “indexing tracking ID" in line 7 is in response to this second request. If the first and second requests are the same, as the naming implies, they each should each have an indexing tracking ID returned. These indexing tracking IDs should be different. However, as claimed, they are recited as being the same. One of ordinary skill in the art would not understand if there are two IDs or just one that is provided in response to two separate requests.

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14. Claim 124 is indefinite because one of ordinary skill in the art would not know whether there is only one end user computer or multiple end user computers. In line 2, the claim recites "an end user computer." In line 11, the claim recites "the end user computer." However, in line 7, the claim recites "one of the end user computers." One of ordinary skill in the art would not understand from the language used in the claim if there is only one end user computer or a plurality of end user computers. As the Examiner has found more evidence to support there being only one end user computer, when applying the prior art, the interpretation that there is only one end user computer has been used.

15. The Examiner finds that because claims 93 and 124-146 are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. Claims 85-87, 89-91, 93, 95-105, 124-132, and 138-147, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Whitehouse (US 6,005,945) in view of An Introduction to Cryptography.

18. As to claim 85, 124, 132, 140, 141, 142, , and 147, Whitehouse shows:

f. In a vendor-controlled centralized postage-issuing computer system **102**, a method of processing a mail piece, comprising:

g. receiving (“Provide User Inputs,” Figure 3), at the vendor-controlled centralized postage-issuing computer system, an indexing tracking ID request (the serial number is part of the indicium, Table in column 13, therefore it is requested along with the request for the indicium) and a first postage indicium request (Figure 5A, step 200), directed from an end user computer (“User Computer,” Id.);

h. allocating an indexing tracking ID for the end user computer (Figure 5A, step 214);

i. generating data corresponding to a postage indicium **215** at a vendor-controlled centralized postage issuing computer system (Figure 6) in response to the postage indicium request (Figure 13, step 600), the postage indicium being associated with a mail piece (printed on it; Column 13, lines 56-60) and configured for processing through the United States Postal Service (USPS) (“The present invention also provides the technical means for postal agencies such as the USPS;” Column 1, lines 43-49), wherein the data corresponding to the postage indicium comprises a digital signature (“digital signature signed with user’s private key,” Figure 5A, step 200)

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- j. storing the data corresponding to the postage indicium within a database of the vendor- controlled centralized postage issuing computer system (Figure 4, element 174) such that the indexing tracking ID (Piece Number/Serial Number, Column 11, line 21) is associated with the data corresponding to the postage indicium and the indexing tracking ID is usable as an index for the data corresponding to the postage indicium (Column 13, lines 38-40);
 - k. transmitting the indexing tracking ID (as part of the indicium, Column 13, lines 20-22) to the end user computer **104** (Figure 6);
 - l. receiving, at the vendor-controlled centralized postage issuing computer system, a postage indicium request directed from the USPS **180** (Figure 4 & Columns 8-9, lines 63-12), wherein the second postage indicium request contains the indexing tracking ID (serial number; Id.);
 - m. retrieving the data corresponding to the postage indicium from the database based on the indexing tracking ID received from the USPS (Id.).
19. Whitehouse does not expressly show:
- n. a digital signature derived from the indexing tracking ID;
 - o. a digital signature derived from a USPS delivery confirmation code;
 - p. a digital signature from a data set that includes the indexing tracking ID and not a delivery zip code for the mail piece.
20. However, An Introduction to Cryptography shows that any data can be incorporated into a digital signature and by the use of the digital signature, the data is verified (Pages 18-19 & Figure 1-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time

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of the invention to have modified the teachings of Whitehouse to include the indexing tracking ID or the USPS delivery confirmation code in the digital signature in order to verify the ID or code as well as the originator (Id.).

21. As to claims 86 and 125, Whitehouse further shows:

the indexing tracking ID is unique within the USPS for at least one year (unique without a time period is interpreted as being unique for all time periods, which clearly extends past one year; Column 13, lines 38-40).

22. As to claims 87 and 126, Whitehouse further shows:

the data corresponding to the postage indicium comprises data representative of one or more items selected from the group consisting of postage amount, date and time of postage information creation, service class, optional data advance, and delivery zip code (column 11, lines 18-29).

23. As to claim 89, Whitehouse further shows:

transmitting the digital signature with the data corresponding to the postage indicium from the vendor-controlled centralized postage issuing computer system to the end user computer (Id.).

24. As to claims 90 and 128, Whitehouse further shows:

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the digital signature is derived by applying a private key to the data corresponding to the postage indicium (Column 13, lines 41-46).

25. As to claims 91, 129, and 130, Whitehouse further shows:

the digital signature is derived within a physically secure coprocessor device (Id.).

26. As to claims 93 and 131, Whitehouse further shows the USPS requesting by the ID, the data to verify the indicium from the central server (Figure 8).

27. As to claim 95, Whitehouse further shows:

transmitting, from the vendor-controlled centralized postage-issuing computer system to the USPS, the data corresponding to the postage indicium after retrieving the data corresponding to the postage indicium (Columns 8-9, lines 63-12, inherently, the data has to be retrieved locally before it can be sent to another device).

28. As to claim 96, Whitehouse further shows:

q. generating a plurality of postage indicium data sets (in the transaction database 174), each data set comprising data corresponding to a postage indicium associated with a mail piece (column 8, lines 59-62);

r. associating a plurality of indexing tracking IDs with the plurality of postage indicium data sets (Column 11, lines 10-29); and

s. storing the plurality of postage indicium data sets within the database **174**.

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29. As to claims 97, 139, and 144, Whitehouse shows as discussed above, but does not expressly show:

the indexing tracking ID is a USPS delivery confirmation code.

30. Nevertheless, the differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data code used. Further, the structural elements remain the same regardless of the specific data code used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Whitehouse to substitute the USPS delivery confirmation code for the piece number or serial number disclosed in order to allow for closer integration with the USPS.

31. As to claim 98, Whitehouse further shows:

the postage indicium request is received from the USPS over the internet (Column 8, lines 23-29).

32. As to claim 99, Whitehouse further shows:

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transmitting the retrieved data corresponding to the postage indicium from the vendor-controlled centralized postage-issuing system to the USPS over the internet (Figure 4, communications interface 152 being an internet connection).

33. As to claim 100, Whitehouse further shows:

the indexing tracking ID and the data corresponding to the postage indicium are transmitted to the end user computer in a format that enables the end user computer to print a one-dimensional bar code representative of the indexing tracking ID and a two-dimensional bar code representative of the data corresponding to the postage indicium (Column 15, lines 18-21).

34. As to claims 101, Whitehouse further shows:

transmitting the retrieved data corresponding to the postage indicium over the internet such that the data can be displayed at the USPS (Figure 4, communications interface 152 being an internet connection as stated in Column 8, lines 23-29).

35. As to claim 102, Whitehouse further shows:

the postage indicium comprises either a meter number or an account number that is not part of the indexing tracking ID (Column 12, lines 57-64).

36. As to claim 103, Whitehouse further shows:

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the data corresponding to the postage indicium is a subset (Column 13, Table of indicium elements) of a larger data set corresponding to the postage indicium (Columns 10-11, lines 45-29).

37. As to claim 104, Whitehouse further shows:

the indexing tracking ID and the data corresponding to the postage indicium are transmitted from the vendor-controlled centralized postage issuing computer system to the end user computer over the internet and the postage indicium request is received from the USPS over the internet (Figure 4, communications interface 152 being an internet connection as stated in Column 8, lines 23-29).

38. As to claims 105 and 138, Whitehouse further shows:

the data corresponding to the postage indicium comprises a meter number or an account number that is not part of the indexing tracking ID (Column 12, lines 57-64).

39. As to claim 127 and 143, Whitehouse further shows:

deriving a digital signature from the data corresponding to the postage indicium (Id.); associating the digital signature with the data corresponding to the postage indicium (“The encryption key ID indicates which key was used to generate the digital signature,” Id.); and storing the digital signature and the data corresponding to the postage indicium within the vendor-controlled centralized postage-issuing computer system (Column 13, lines 38-60).

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40. As to claim 145, Whitehouse further shows:

comparing the indexing tracking ID of the retrieved data corresponding to the postage indicium with the indexing tracking ID received in the second postage indicium request from the USPS (Column 22, lines 44-51).

41. As to claim 146, Whitehouse further shows:

transmitting, from the vendor-controlled centralized postage-issuing computer system to the USPS, an indication of whether the indexing tracking ID of the retrieved data corresponding to the postage indicium and the', indexing tracking ID received in the second postage indicium request received from the USPS are the same (Column 22, lines 52-57).

Response to Arguments

42. Applicant's arguments filed 12 February 2009 have been fully considered but they are not persuasive.

43. Applicants argue:

44. “The present claims are not directed to the use of this postage indicium serial number. To the contrary, the present claims are directed to the use of an indexing tracking ID, i.e., an ID used for tracking purposes (e.g., a USPS delivery confirmation code) that is allocated upon request by the end user” (Remarks, Page 13, Paragraph 2).

45. Examiner's response:

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46. Whether or not it is Applicants' intent to draft claims that allow the serial number to read on the indexing tracking ID claimed, it is shown as performing the same functionality. A unique number on each piece of mail clearly allows for tracking according to that number. As discussed in the '945 patent, one of the advantages of the invention is:

Mail Piece Tracking: Tracking of mail pieces can actually begin prior to the piece being actually physically transferred to the care of the postal agency. And, scanning requirements of the piece as it moves through the mail stream can be reduced as key data have already been collected at the instant the postage indicium was disseminated to the end user.

(Whitehouse, Column 24, lines 46-53).

47. Therefore, the serial number, being the only unique value, allows for tracking just as the USPS delivery confirmation code does.

48. Applicants argue:

49. "The end user computer has the option as to whether to request this indexing tracking ID for the postage transaction and may choose only to request the postage indicium. Thus, the method of the present claims relies on an integration of tracking ID's that is not present in the method disclosed by Whitehouse" (Remarks, Page 13, Paragraph 3).

50. Examiner's response:

51. The option of requesting or not requesting the ID is not claimed. If both values are shown in the instant claims, the arguments to the difference between the values would have more weight. Currently, a tracking value is claimed, and Whitehouse shows a tracking value. The Examiner agrees that two unique values are not shown by Whitehouse. Amending to show both values, provided there is support in the present disclosure, would likely overcome the present rejections.

52. Applicants' other arguments have been considered, however, as they pertain to the amendments for which the grounds of rejection has been altered, they are considered moot.

Conclusion

53. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

54. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

55. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

56. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

57. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621